

REMARKS

The Office Action mailed June 29, 2007 has been received and reviewed. In the Office Action, claims 1-33 were pending in the subject application. More specifically, claims 1-33 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Further claims 1-9 stand rejected under 35 U.S.C. § 112 ¶ 1 as failing to comply with the enablement requirement. Claims 1-31 and 33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,814,510 to Sabbagh et al. (hereinafter the “Sabbagh reference”). Finally, claim 32 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Sabbagh reference in view of U.S. Patent Application No. 2002/0188646 to Terrill et al. (hereinafter the “Terrill reference”). Reconsideration of the present application in view of the above amendments and the following remarks is respectfully requested.

Summary of Telephonic Interview

Applicants would like to thank Examiner Lett for granting a telephonic interview on September 12, 2007, and for considering proposed amendments and arguments regarding deficiencies in the prior art, including the Sabbagh reference and the Terrill reference.

During the interview, Applicants attempted to clarify that the claimed invention involves automatically configuring clients upon installation of a network device. Examiner Lett suggested that applicants include the installation language as part of a claim limitation, in addition to including the language in the preamble of the claims. Additionally, removing “bi-directional” that preceded “request” and “response” in claim 1 for clarification purposes. Finally, Examiner Lett suggested the Applicants clarify the claim language “bi-directional values.” The present communication is submitted in this regard.

Rejections based on 35 U.S.C. § 101

The United States Supreme Court has recognized that the expansive language of 35 U.S.C. § 101 includes as statutory subject matter “anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09 (1980). The USPTO has adopted the Supreme Court’s interpretation and has stated that, in practice, the complete definition of the scope of 35 U.S.C. § 101 “is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent.” MPEP 2106(IV)(A). More specifically, the MPEP states that “computer programs are often recited as part of a claim.” MPEP 2106.01(I). In considering such claims, “USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim.” *Id.*; *see also In re Beauregard*, 53 F.3d 1582 (Fed. Cir. 1995). “The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program.” MPEP 2106.01(I).

Claims 1-33 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully submit that the following remarks and corresponding amendments overcome the rejection and, thus, Applicants respectfully request withdrawal of the 35 U.S.C. § 101 rejections.

As amended herein, independent claims 1 and 10 recite, in part, *a computer storage medium* for storing information related to automatic configuration upon installation of a network printer. Applicants respectfully submit that independent claims 1 and 10, as currently amended, as well as those claims depending from independent claims 1 and 10, are not merely

directed to software constructs. Instead, the claims are directed to a statutory machine or manufacture because a computer storage medium is a tangible object. Stated differently, the computer storage medium of claims 1 and 10 is “a computer element which defines structural and functional interrelationships between a computer program and the rest of the computer.” *See* MPEP § 2106.01. Applicants respectfully submit that the currently amended claiming strategy has long been deemed proper. *See, e.g., In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995). Accordingly, claims 1-20 are directed to statutory subject matter. Therefore, withdrawal of the 35 U.S.C. § 101 rejection of claims 1-20 is respectfully requested.

Further, Applicants respectfully submit that independent claims 21 and 31, and the claims depending on independent claims 21 and 31 recite a statutory process for automatic configuration as originally presented. Here, even assuming the claims are directed to a judicial exception—which Applicants respectfully submit they are not—claims 21-33 would be directed to statutory subject matter because the claims are a practical application in that they produce a useful, concrete and tangible result. *See, e.g.,* MPEP § 2106(IV). The processes of claims 21-33 produce a result that is useful because it automatically configures a system upon installation of a network printer; the result of the process is concrete because the result is substantially repeatable; and the result of the process is tangible because it sets forth a practical application and produces a real-world result. *See id.* Accordingly, claims 21-33 are directed to statutory subject matter. Therefore, withdrawal of the 35 U.S.C. § 101 rejection of claims 1-33 is respectfully requested.

Rejections based on 35 U.S.C. § 112 ¶ 1

“A conclusion of lack on enablement means that, based on the evidence . . . the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation.

In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).” MPEP § 2164.01(a). “As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. § 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).” MPEP § 2164.01(b).

Claims 1-9 stand rejected under 35 U.S.C. § 112 ¶ 1 as failing to comply with the enablement requirement. Applicants respectfully submit that the following remarks overcome the rejection and, thus, Applicants respectfully request withdrawal of the 35 U.S.C. § 112 ¶ 1 rejections.

Here, claim 1 has been amended to strike the limitation “bi-directional” before the claim terms “request” and “response.” Applicants respectfully submit that this amendment overcomes the 35 U.S.C. § 112 ¶ 1 rejection of claims 1-9. Additionally, Applicants respectfully submit that the Specification is enabling because it provides significant detail, teaching someone skilled in the art to make and use the invention more than adequately for enablement purposes. *See generally Specification*. Further, the specification discloses exemplary methods for making and using the claimed invention. *See, e.g., Specification* at ¶ [0055]; FIG. 6. Thus, Applicants respectfully submit that the Specification enables claims 1-9 and, accordingly, withdrawal of the 35 U.S.C. § 112 ¶ 1 rejection of claims 1-9 is respectfully requested.

Rejections based on 35 U.S.C. § 102(e)

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdeggal Brothers v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . .

claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 19133, 1920 (Fed. Cir. 1989); *see also*, MPEP § 2131.

Claims 1-31 and 33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the Sabbagh reference. As the Sabbagh reference does not describe, either expressly or inherently, each and every element of the rejected claims, Applicants respectfully traverse the rejection as hereinafter set forth.

As amended herein, independent claim 1 recites a system for automatic configuration upon installation of a network printer, wherein the network printer is associated with printer description files, a driver, a spooler, and a port monitor which comprises, in part, a syntax within the *printer description files* for representing and associating the bi-directional request and the bi-directional response with a print feature, the *syntax including one or more extensions to the printer description files*. As stated in the Specification, “the extensions allow a client 200 to define a question to ask and how to interpret the answer.”

By way of contrast, the Sabbagh reference is directed to updating printer drivers. *See generally Sabbagh reference*. The Sabbagh reference fails to anticipate currently amended claim 1 for at least two reasons. First, the Sabbagh reference is merely directed toward updating printer drivers, while the system of independent claim 1 is directed to configuring the drivers *upon installation*. *See id.* Indeed, the claim itself states that the invention is directed to automatic configuration *upon installation*. *See generally Specification*. The Sabbagh reference, in contrast, teaches “allowing updating of printer configurations in a print server.” *See Sabbagh reference* at col. 2, ll. 47-48. Thus, the Sabbagh reference fails to disclose, either expressly or inherently, configuration upon installation as required by currently amended claim 1. Second, the Sabbagh reference fails to disclose bi-directional communication through a syntax extension

to existing printer description files. *See generally Sabbagh reference.* Indeed, the Sabbagh reference fails to disclose printer description files as used in independent claim 1 at all. *See id.* Moreover, the Sabbagh reference fails to show the identical invention in as complete detail as contained in the claim. Thus, claim 1 is not anticipated by the Sabbagh reference. Therefore, withdrawal of the 35 U.S.C. § 102(e) rejection of this claim is respectfully requested.

With reference to claim 10, a system for facilitating client retrieval of bi-directional information upon installation of a network device is recited that comprises, in part, a set of bi-directional constructs within a printer description file. Similar to the discussion previously presented, the Sabbagh reference fails to disclose each of the elements of independent claim 10 for at least two reasons. First, the Sabbagh reference is directed to upgrading printers, rather than configuration at installation. Second, the Sabbagh reference fails to disclose bi-directional constructs within a printer description file. Accordingly, it is respectfully submitted that the Sabbagh reference fails to describe, either expressly or inherently, each and every element of independent claim 10. Moreover, the Sabbagh reference fails to show the identical invention in as complete detail as contained in the claim. Thus, claim 10 is not anticipated by the Sabbagh reference. Therefore, withdrawal of the 35 U.S.C. § 102(e) rejection of this claim is respectfully requested.

With reference to claim 21, a method is recited for automatically configuring a system upon installation of a network printer within the system, wherein the system includes printer description files, a driver, a spooler, and a port monitor which comprises, in part, getting a list of installable features and corresponding bi-directional requests from the printer description files. As previously stated, the Sabbagh reference fails to disclose each of the elements of independent claim 21 for at least two reasons. First, the Sabbagh reference is directed to

upgrading printers, rather than configuration at installation. Second, the Sabbagh reference fails to disclose bi-directional constructs within a printer description file. Accordingly, it is respectfully submitted that the Sabbagh reference fails to describe, either expressly or inherently, each and every element of independent claim 21. Moreover, the Sabbagh reference fails to show the identical invention in as complete detail as contained in the claim. Thus, claim 21 is not anticipated by the Sabbagh reference. Therefore, withdrawal of the 35 U.S.C. § 102(e) rejection of this claim is respectfully requested.

With reference to claim 31, a method is recited for providing extensibility for a port monitor in order to enable vendors to define new mappings using existing public bi-directional schema and extensions to existing schema which comprises, in part, permitting the use of an extension file capable of describing a mapping between bi-directional values and device-specific objects. As stated previously, the Sabbagh reference fails to disclose extensibility using extensions to existing schema, as required by independent claim 31. Further, similar to the discussion above, the Sabbagh reference is directed to upgrading printers, rather than configuration at installation. Accordingly, it is respectfully submitted that the Sabbagh reference fails to describe, either expressly or inherently, each and every element of independent claim 31. Moreover, the Sabbagh reference fails to show the identical invention in as complete detail as contained in the claim. Thus, claim 31 is not anticipated by the Sabbagh reference. Therefore, withdrawal of the 35 U.S.C. § 102(e) rejection of this claim is respectfully requested.

As the Sabbagh reference fails to describe, either expressly or inherently, each and every element of independent claims 1, 10, 21, and 31, it is respectfully submitted that these claims are not anticipated by the Sabbagh reference. Each of claims 2-9, 11-20, 22-30, and 33 depends, either directly or indirectly, from one of claims 1, 10, 21, and 31 and is, accordingly,

not anticipated by the Sabbagh reference for at least the above-cited reasons. Accordingly, withdrawal of the 35 U.S.C. § 102(e) rejection of claims 2-9, 11-20, 22-30, and 33 is respectfully requested.

Rejections based on 35 U.S.C. § 103

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestion or motivation found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See, *Application of Bergel*, 292 F. 2d 955, 956-957 (1961). Thus, in order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See MPEP § 2143. Recently, the Supreme Court

elaborated, at pages 13-14 of *KSR*, it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *KSR v. Teleflex*, 127 S. Ct. 1727 (2007).

Claim 32 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Sabbagh reference in view of the Terrill reference. As a *prima facie* case of obviousness has not been established, Applicants respectfully traverse this rejection as hereinafter set forth.

Claim 32 depends from claim 31 which recites, in part, a method for providing extensibility for a port monitor in order to enable vendors to define new mappings using existing public bi-directional schema and extensions to existing schema which comprises, in part, permitting the use of an extension file capable of describing a mapping between bi-directional values and device-specific objects. As previously stated, the Sabbagh reference fails to disclose extensibility using extensions to existing schema, as required by independent claim 31. Further, the Sabbagh reference is directed to upgrading printers, rather than configuration at installation. The deficiencies of the Sabbagh reference are not overcome by the addition of the Terrill reference which monitors pre-print and post-print information and utilizes XML. *See generally Terrill reference*. Thus, Applicants respectfully submit that the Sabbagh and Terrill references, either alone or in combination, fail to teach or suggest each of the limitations of dependent claim 32 under 35 U.S.C. § 103(a). Therefore, a *prima facie* case of obviousness has not been established for dependent claim 32, and Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of this claim.

CONCLUSION

For at least the reasons stated above, claims 1-33 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of claims 1-33. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action.

No other fee is believed due in connection with this Amendment, but the Commissioner is hereby authorized to charge any additional amount required or to credit any overpayment to Deposit Account No. 19-2112, referencing attorney docket number MFCP.103203.

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Respectfully submitted,

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